

IN RESPONSE TO THE OFFICE ACTION:

CLAIM OBJECTIONS AND REJECTIONS UNDER 35 U.S.C. § 112:

Claim 1 has been objected to for not including parenthesis around all reference numerals in the claim. Correction has been affected.

Claim 2,3 and 5-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response, the claims have been amended addressing the specific concerns indicated by the Examiner in the Office Action.

Applicant submits that the above amendments obviate the objection and rejections of the claims under 35 U.S.C. § 112, second paragraph and thus ask that the Examiner reconsider and withdraw the rejection of the claims and indicate their allowance in the next paper from the Office.

REJECTIONS UNDER 35 U.S.C. § 102(e):

Claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Steen (US 6,869,377). In the action, however, it is stated (at page 4, top paragraph) that

"[t]he changes made to 35 U.S.C. 1029e) by the American Inventors Protection Act of 1999 (AIPA) and the . . . do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. § 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e))."

This, however, is a misinterpretation of the application of the law. In fact, the determination as to whether to use pre- or post-AIPA law is based on the filing date of the application at hand not that of the reference being considered. Therefore, Applicant respectfully requests that the rejection be reconsidered, and at a minimum, *the next Office Action be made non-final.*

This being said, Applicant has amended claim 1 to include the limitation of claim 2 in an effort to bring it into consonance with international counterpart patents. In this regard, it is respectfully pointed out that US 6,869,377 to Steen discloses that a free wheel function is activated at either zero throttle value or at activation of any engine brake (see column 4, beginning line 16), but further, Steen '377 does not disclose that a:

control unit is arranged to activate a free wheel function at at least one of the following driving conditions when driving with a predetermined speed (vset; vcc):
i) the vehicle is considered to accelerate at an activated free wheel function, and retard without an activated free wheel function; ii) the vehicle is considered to maintain constant speed at an activated free wheel function and retard without an activated free wheel function, and iii) the vehicle is considered to retard at an activated free wheel function and retard without an activated free wheel function

as now-recited in claim 1¹. The benefits of the claimed limitations are significant in that enhanced fuel economy is provided to the incorporating vehicle. In view thereof, neither claim 1 nor any claim that depends therefrom (which is all of the additional claims in the application) is anticipated by Steen '377 or rendered obvious.

It is believed that the application is in condition for allowance. Therefore, a Notice to that effect is respectfully solicited.

¹ For there to be anticipation under 35 U.S.C. §102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990).

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The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Order No. 00173.0053.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tracy W. Druce", written in a cursive style.

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